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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/001,297	11/02/2001	Roland Boss	10011080-1	2488

7590 11/19/2003

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

GOFF II, JOHN L

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/001,297

Applicant(s)

BOSS, ROLAND

Examiner

John L. Goff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 5 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-13, 15 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group I, Species I, Sub-Species I-I-A, and Sub-Species I-II-B (claims 1-4, 6-13, 15, and 16) in Paper No. 3 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 10, 11, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Olson (U.S. Patent 3,664,912).

Olson discloses a method of binding a plurality of sheets into a bound stack to form a book, magazine, pamphlet, brochure, etc. Olson teaches providing a plurality of sheets (e.g. paper sheets), applying a binding/protective coating to at least a portion of each sheet, overlaying the plurality of sheets to form a stack, and applying binding energy (e.g. heat and pressure) to the stack in a binding region such that the binding/protective coating of each sheet fuses to adjacent sheets in the stack to form a multiple paper form such as a book, magazine, pamphlet, brochure,

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etc. that can be printed on (Figures 1 and 2 and Column 1, lines 11-23 and Column 5, lines 10-15).

4. Claims 1-4, 10, 11, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Osogoshi et al. (JP 08052827 and see also the English abstract and machine translation).

Osogoshi et al. disclose a method of binding a plurality of sheets into a bound stack to form a book, calender, magazine, notebook, etc. Osogoshi et al. teach providing a plurality of sheets (e.g. paper sheets), applying a binding/protective coating to at least a portion of each sheet, optionally printing the coated sheets, overlaying the plurality of sheets to form a stack, and applying binding energy (e.g. heat and pressure) to the stack in a binding region such that the binding/protective coating of each sheet fuses to adjacent sheets in the stack to form a multiple paper form such as a book, calender, magazine, notebook, etc. that can be (optionally) further printed on (English abstract and paragraphs 8, 10, and 14 of the machine translation).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 6-9, 12, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olson.

Regarding claims 6, 13, and 15, as noted above Olson teaches using a plurality of sheets having binding/protective coatings to form books, magazines, pamphlets, brochures, etc. such

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that one of ordinary skill in the art at the time the invention was made would have readily appreciated that using a plurality of sheets as taught by Olson would have included using at least three sheets to form the above products.

Regarding claims 7-9 and 12, Olson does not specifically teach all the various binding regions claimed. However, it is noted Olson teaches forming books, magazines, pamphlets, brochures, etc. such that it would have been obvious to one of ordinary skill in the art to bond the plurality of sheets taught by Olson in the different claimed binding regions in order to form the above products.

7. Claims 6-9, 12, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osogoshi et al.

Regarding claims 6, 13, and 15, as noted above Osogoshi et al. teach using a plurality of sheets having binding/protective coatings to form book, calender, magazine, notebook, etc. such that one of ordinary skill in the art at the time the invention was made would have readily appreciated that using a plurality of sheets as taught by Osogoshi et al. would have included using at least three sheets to form the above products.

Regarding claims 7-9 and 12, Osogoshi et al. do not specifically teach all the various binding regions claimed. However, it is noted Osogoshi et al. teach forming books, calenders, magazines, notebooks, etc. such that it would have been obvious to one of ordinary skill in the art to bond the plurality of sheets taught by Osogoshi et al. in the different claimed binding regions in order to form the above products.

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*Conclusion*

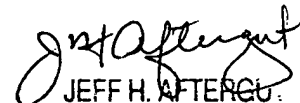
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John L. Goff** whose telephone number is **703-305-7481** (after December 2003 the telephone number will be 571-272-1216). The examiner can normally be reached on M-Th (8 - 5) and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 703-308-3853. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



John L. Goff



JEFF H. AFTERGUT  
PRIMARY EXAMINER  
GROUP 1300